

III. REMARKS

1. Claims 1-8, 11-15 and 20 are not unpatentable under 35 U.S.C. §103(a) over Moon et al. (U.S. Patent No. 6,433,801) and further in view of Gerpheide (U.S. Patent No. 6,473,069) and Miyasato (JP 403048922) (hereafter Moon, Gerpheide and Miyasato), because the combination of the three references, which Applicant submits is improper, does not disclose or suggest each feature or Applicant's invention as claimed.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the references, when combined, must teach or suggest all of the claim limitations. (M.P.E.P. §2142 et seq.).

Claim 1 recites that movement with respect to the touch sensitive region causes an indicator to move across the display. Moon makes no such disclosure. In Moon, one can use a "mouse or other pointing device" to make a menu selection choice. (Col. 6, lines 25-30). Or, a "stylus, cursor or mouse based pointing device" can be used to make the selection. However, Moon does not disclose or suggest that "movement with respect to the touch sensitive region causes an indicator" to move across the display. Contrary to what the Examiner states, there is simply no disclosure in Moon that a cursor button "would activate a cursor to appear on the screen for movement." FIG. 4 does not show such a feature and Moon does not disclose or suggest that "movement with respect to the touch sensitive region causes an indicator to move across the display."

Gerpheide is directed to a "drag function" that is activated when the user's finger reaches the edge region of the touchpad that is a different texture (Abstract). This does not disclose or suggest Applicant's invention. First, Gerpheide does not

disclose or suggest "at least one function being selectable via each active region." Rather, in Gerpheide, the touchpad surface, which is separate from the display, is divided into two regions. A border region 64 and inner region 66. (Col. 7, lines 56-67). The user can select an object on the display using the touchpad in the inner region. (Col. 9, lines 24-26). The object can be dragged across the display and only when the user's finger crosses onto the border region of the touchpad with material 70, is the drag extend function accessed. (Col. 9, lines 28-31). This is not the same as in Applicant's invention where the indicator can "move only from one active region to another" as recited in claim 1. In Gerpheide, the "user moves the finger to drag the selected object across the display." (Col. 9, lines 28-29). If the user's finger never reaches the "ridge of material 70" on the touchpad the drag extend function will not be accessed by the touchpad microcontroller, and will not be activated. (Col. 9, lines 29-31). Thus, in Gerpheide, the user could drag or move the object across or over the display all day long without even activating the "drag extend" function. This is quite unlike Applicant's invention where the indicator can move only from one active region to another active region.

Miyasato does not disclose or suggest an indicator that "is arranged to move only from one active region to another" as claimed by Applicants. All Miyasato discloses is "predicting where a cursor is moving and skipping to an icon in the predicted area." This is not at all the same as an indicator that can only move from "one active region to another active region."

Referring to FIG. 2 of Miyasato, the cursor 9 starts at a position that is not an "active area." In Miyasato, it is quite evident that the cursor is free to move around a display and

outside of any active region, such as icon 10. Miyasato merely takes a current position of the cursor and "predicts" which icon the cursor is headed to. However, the cursor need not start in an active area. Thus, Miyasato does not disclose or suggest an arrangement where the cursor can move only from one active region to another as is claimed by Applicant.

Each reference cited by the Examiner lacks any disclosure or suggestion of at least one feature of Applicant's invention, and the combination of the three references does not overcome the deficiencies.

Moon does not disclose or suggest that movement with respect to the touch sensitive region causes an indicator to move across the display or that an indicator can move only from one active region to another. Although Gerpheide discloses moving a cursor across the display, there is no disclosure or suggestion that an object being dragged across the screen can only be moved from one active region to another. Rather, the object can be moved anywhere within the display, which is not the same as from one active region to another. It is only if the user's finger reaches the material region that the "drag extend" function will be accessed. However, the user's finger need not access the material region if the "drag extend" function is not needed. Thus, the object or cursor in Gerpheide does not move "only from one active region to another."

And finally, Miyasato also does not disclose or suggest this feature because in Miyasato the cursor is free to move around outside of active regions such as icon 10. Thus, Miyasato also does not disclose or suggest moving "only from one active region to another" as is recited by Applicant in both claims 1 and 14.

Claims 2-13 and 15-23 should be allowable at least in view of their respective dependencies.

2. Furthermore, it is not proper, for purposes of 35 U.S.C. §103(a), to combine Moon, Gerpheide and Miyasato, to obviate Applicant's invention, since there is no motivation or suggestion in any of the references to combine the references in the manner proposed by the Examiner. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, Moon, Gerpheide and Miyasato do not disclose or suggest each feature of Applicants' invention as claimed. Thus, at least for that reason, a *prima facie* case of obviousness cannot be established.

Applicants also submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Moon, Gerpheide and Miyasato. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). Moon, as shown in FIG. 4, merely shows a number of functions on the graphical user interface that can be chosen by the user. (Col. 6 lines 45-46). The controls are appropriately spaced and sized to allow finger navigation. (Col. 6, lines 58-60). However, there is nothing at all in Moon that

would lead one to consider arranging an indicator "to move only from one active region to another" as claimed by Applicant. Such a feature in Moon would make the device cumbersome to use, if not unworkable, because of the number of accessible features and menu options on the display. Thus, Moon lacks the requisite motivation under 35 U.S.C. §103(a).

Gerpheide is merely directed to adding a "drag extend" function to a touch sensitive surface that is separate from the display. Moon does not require such a function since the objects are within the display area of the graphical user interface, and the user access the functions and menus directly on the display. There is nothing in Moon to disclose or suggest a need for an additional "touchpad surface." In Gerpheide, the invention relates to the "touchpad surface", not the display. As is clearly seen in FIG. 3 of Gerpheide, the touchpad 32 is not part of the display 20. (Col. 7, lines 24-33). Thus, the touchpad surface can be much smaller in relation to the display 20 requiring the need for the "drag extend" function. Thus, the touchpad of Gerpheide is not a "touch screen display" as disclosed by Moon. Thus, since the systems are unrelated, there can be no suggestion or motivation to combine the references.

There is also no motivation to combine Moon with Miyasato. Nothing in Moon suggests any need to skip to an object set in the predictive moving direction. Furthermore, such a function in Moon would only complicate the usability of Moon given the layout, such as shown in FIG. 4. There are a number of objects in the display of Moon that could be considered to be in the predictive moving direction. "Skipping" to one, may not necessarily be the desired one, since more than one object lies on any given direction vector, and the vectors can be very close.

Undesired "skipping" would only frustrate a user, particularly when the user might desire to go to another object than the one skipped to. Thus, there is nothing in Moon that would lead one to search for or desire such a feature.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Moon, Gerpheide and Miyasato under 35 U.S.C. §103(a) is not established. Thus, claims 1-23 should be allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.



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Respectfully submitted,

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